

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

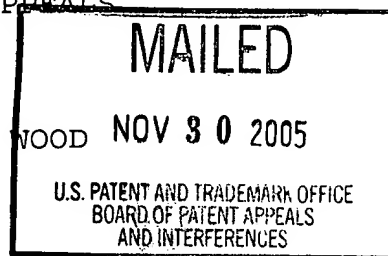
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS HUNTINGTON WOOD

Appeal No. 2005-2441
Application 09/332,264

ON BRIEF



Before HAIRSTON, KRASS, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 2, 4, 5 and 7-15, which constitute all the claims pending in this application.

The disclosed invention pertains to a data communications system which increases the applicability of Ethernet functionality, particularly to the area of residential data delivery.

Representative claim 1 is reproduced as follows:

1. A data communications system comprising:

an outside plant, the outside plant including a distribution fiber, a splitter and a plurality of drop fibers;

a head-end, the head-end further comprising an Ethernet adapter circuit and being coupled to the splitter via the distribution fiber;

a first network unit, the first network unit being coupled to the splitter via a first of the plurality of drop fibers, wherein the first network unit receives a first upstream data stream from a first user source via an Ethernet interface, modulates a first signal with the first upstream data stream and transmits the modulated first signal to the head-end via the outside plant; and

a second network unit, the second network unit being coupled to the splitter via a second of the plurality of drop fibers, wherein the second network unit receives a second upstream data stream from a second user source via an Ethernet interface, modulates a second signal with the second upstream data stream and transmits the modulated second signal to the head-end via the outside plant,

whereby the first and second network units can transmit the modulated first and second signals to the head-end substantially simultaneously without collision.

The examiner relies on the following references:

Bohn et al. (Bohn)	5,311,344	May 10, 1994
Zirngibl	5,550,666	Aug. 27, 1996
Feldman et al. (Feldman)	6,137,607	Oct. 24, 2000
		(filed Feb. 23, 1998)
Sorrells et al. (Sorrells)	6,542,722	Apr. 01, 2003
		(filed Apr. 16, 1999)
Lewin et al. (Lewin)	6,587,476	July 01, 2003
		(filed May 26, 1999)

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The following rejections are on appeal before us:

1. Claims 1, 2, 4, 5, 7, 10 and 12-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bohn in view of Lewin.

2. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bohn in view of Lewin and Feldman.

3. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bohn in view of Lewin and Sorrells.

4. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bohn in view of Lewin and Zirngibl.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's

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arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

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776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 1, 2, 4, 5, 7, 10 and 12-15 based on Bohn and Lewin. With respect to independent claim 1, the examiner essentially finds that Bohn teaches the claimed invention except that Bohn does not teach an Ethernet adapter circuit in the head-end and Bohn does not teach

the Ethernet interface for providing the upstream data. The examiner notes that Ethernet is a popular network interface for most computers and that Lewin teaches an Ethernet switch for combining data from individual subscribers. The examiner finds that it would have been obvious to the artisan to use Ethernet switches and interfaces in the system of Bohn [answer, pages 3-4].

Appellant argues that the examiner has failed to establish a prima facie case of obviousness because the references of record fail to teach Ethernet interfaces in first and second network units that modulate first and second signals in first and second upstream data streams in an optically based data communication system. Specifically, appellant argues that the mere popularity of a feature such as Ethernet cannot be used as suggestion or motivation to combine teachings. Appellant also argues that there is no reasonable expectation of success in incorporating Ethernet into the system of Bohn. Appellant also argues that there is no advantage to be gained by introducing Ethernet into Bohn's system because Bohn already solved the same problem of collision less transmission. Finally, appellant argues that the examiner has picked and chosen selected portions of the applied prior art in order to reconstruct the claimed invention in hindsight [brief, pages 8-13].

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The examiner responds that the popularity of Ethernet is relevant to the obviousness of the claimed invention and was well known to the artisan as taught by Lewin. The examiner asserts that the artisan would have been motivated to incorporate Ethernet into Bohn's system so as to make Bohn's system compatible with existing computer equipment [answer, pages 7-9].

Appellant responds that the popularity of Ethernet is not in and of itself a suggestion or motivation to combine or modify the prior art. Appellant notes that there was no apparent disadvantage to the system of Bohn which would have motivated the artisan to add Ethernet to the system of Bohn [reply brief].

We will not sustain the examiner's rejection of claims 1, 2, 4, 5, 7, 10 and 12-15 based on Bohn and Lewin for essentially the reasons argued by appellant in the briefs. Most importantly, we agree with appellant that the popularity of Ethernet by itself is insufficient motivation to add Ethernet capability to the system of Bohn. There is nothing in the description of the Bohn system which suggests that Ethernet compatibility within the Bohn system is either necessary or even desirable. In our view, there is nothing on this record which would have led the artisan to modify Bohn to include Ethernet capability. The only apparent reason for making the modification proposed by the examiner comes from an improper attempt to recreate the claimed invention in

hindsight. The evidence provided by the examiner is simply insufficient to support the examiner's findings of obviousness.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2, 4, 5 and 7-15 is reversed.

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